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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,539	08/17/2001	Gavin J. McIntosh	FMCE-P064	3957

7590 07/21/2003
Henry C. Query, Jr.
504 S. Pierce Ave.
Wheaton, IL 60187

EXAMINER

DOUGHERTY, JENNIFER R

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,539

Applicant(s)

MCINTOSH, GAVIN J.

Examiner

Jennifer R. Dougherty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on August 21, 2000. It is noted, however, that applicant has not filed a certified copy of the United Kingdom application as required by 35 U.S.C. 119(b).
2. In response to applicant's request on page 1 of the response filed June 27, 2003, the application file has been thoroughly checked and no certified copy of the UK application is present, nor was the receipt of the UK application even recorded in the file.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 3, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al. (US 4,082,147).
The invention of Wolff et al. includes all the limitations of claim 1 including: a production Christmas tree (figure 1) having multiple outlets extending from a single production bore (figure 1).

With respect to the dependant claims, Wolff et al. also teaches: two production outlets (figure 1)-claim 3; a horizontal tree (figure 1)-claim 6; and each outlet with a valve (WV1/WV2)-claim 7.

Claim Rejections - 35 USC § 103

5. Claims 2, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. alone.

As discussed above Wolff et al. discloses all the limitations of claims 2, 4, and 5 with the exception of disclosing the claimed outlet sizes. However, the sizing of an outlet is simply a design choice. An outlet is designed depending on the environment it will be used in. Depending on the environment the outlet is used in, the size of the outlet bores will vary. Thus at the time of the invention it would have been obvious for one having ordinary skill in the art to have sized the outlets in the manner claimed in claims 2, 4, and 5 because it is known in the art to change the size of a well production outlet depending on the environment the outlet is to be used in.

Response to Arguments

6. Applicant's arguments filed 6/27/03 have been fully considered but they are not persuasive.

Multiple Production Outlets

Though Wolff et al. does not specifically state that the two passages (containing valves WV-1 and WV-2) are connected to the production bore; a complete reading of the

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patent proves that this must be true. First, Wolff et al. states that the christmas tree (X) is connected to the production tubing (T) and that the WV valves control the flow of fluids in the christmas tree (column 3, lines 33-56). This certainly suggests that fluid is flowing from T to X and out through the WV valves. In addition, the WV valves are attached to the emergency shutdown system (ESD) (column 4, lines 40-61). If both valves were not conducting the production stream, there would be no need to connect both of them to the emergency shutdown. Finally, Wolff et al. states that in order to shut in the well, both WV valves must be closed before the master valve (MV) to prevent damage from the MV trying to close on a moving stream (column 16, lines 48-57). If both WV valves were not controlling the production stream flowing through the MV, then it would not be necessary to close both of them before closing the MV to prevent damage to the MV.

Horizontal Christmas Tree

In figure 1 and on page 2 of the instant application, applicant states that horizontal Christmas trees have a horizontal production outlet branched off a vertical bore. Thus, per applicant's definition, Wolff et al. does show a horizontal christmas tree: it has horizontal production outlets (outlets with the WV valves) branching off a vertical bore (T).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dougherty whose telephone number is (703) 308-6365. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

jrd

July 16, 2003



DAVID BAGNELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600